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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,164	09/15/2003	C. Daniel McClain	ROWL-10064	2837
7590 05/21/2004			EXAMINER	
Jared S. Goff Schmeiser, Olsen & Watts LLP 18 East University Drive, #101 Mesa, AZ 85201			WOOD, ELIZABETH D	
			ART UNIT	PAPER NUMBER
			1755	
DATE MAILED: 05/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/663,164	Applicant(s) MCCLAIN ET AL.	
	Examiner Elizabeth D. Wood	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/23/03 10/24/03 9/15/03</u> | 6) <input type="checkbox"/> Other: ____  |

### ***Specification***

The examiner has not checked the specification to the extent necessary to determine the presence of **all** possible minor errors (grammatical, typographical and idiomatic). Cooperation of the applicant(s) is requested in correcting any errors of which applicant(s) may become aware of in the specification, in the claims and in any future amendment(s) that applicant(s) may file.

Applicant(s) is also requested to complete the status of any copending applications referred to in the specification by their Attorney Docket Number or Application Serial Number, **if any**.

The status of the parent application(s) and/or any other application(s) cross-referenced to this application, **if any**, should be updated in a timely manner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,531,537 to Friel et al.

The claimed invention involves a method for producing a paint composition comprising various embodiments. Exemplary of the invention is a process comprising providing a (computer-controlled) apparatus at the point-of-sale on which a user selects paint characteristics, after which the (pre-paint) components necessary to provide such characteristics are dispensed or deposited into empty receptacles and agitated to produce a final paint composition.

Friel et al. are relied upon to teach substantially the same invention set forth in the instant claims. Friel et al. disclose methods for producing various paint lines by employing premixed pre-paint aqueous solutions. Friel et al. teach known paint components such as pigments, thickeners, resins and so forth such as those set forth in

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the instant claims. They disclose such process to take place both at manufacturing facilities and point-of sale facilities. See particularly column 6 – column 7, column 8, lines 41-51, the examples and the claims.

In view of the foregoing, the Friel et al. disclosure is considered to differ from the instantly claimed invention only in the scope of coverage. However, the instantly claimed invention significantly overlaps in scope with the patented claims and disclosure and the two inventions are therefore directed to the same inventive concept. The instant claims would have been obvious because overlapping subject matter has long been held to constitute a prima facie case of obviousness.

Any minor differences in the limitations of the dependent claims have been considered. This statement is meant to include limitations such as storing or transferring the solutions prior to selling paint. Clearly these limitations are necessary to the practice of the patented invention and therefore represent simple design choice by manufacturers and retailers.

Furthermore, any such differences such as the particular paint components added are deemed to be result-effective variables that one of ordinary skill in the art would be expected to manipulate to advantage. For example, adding a thickener is obvious for a known reason, i.e. thickening and the results of such addition are predictable. Additionally, such limitations can be considered to have been simply known as conventional to the artisan practicing in the art at the time the invention was made and/or were common practices which were so well known in the art that they would have been taken for granted. MPEP 706.02(a).

If applicants believe that one or more limitations are critical to the invention, then applicant should amend the claims to reflect such critical limitations as well as indicate where in the specification such critical limitations were discussed and demonstrated.

The limitations of all claims have been considered and are deemed to be within the purview of the prior art.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Italian document PS98A000005, the Orcun et al. article, the Duthelliet article, the Grundfelt-Forsius article, the "Dispensing Paint System" document, the "Benefits of delayed product differentiation" document, the "Component Mixing - A new approach to

Customized paint production" document, U.S. Patent No. 5,672,649 or U.S. Patent No. 4,403,866.

For the sake of simplicity and to avoid undue confusion and duplication, the applied references will be discussed together as a group because they are considered to disclose substantially the same inventive concept.

The claimed invention involves a method for producing a paint composition comprising various embodiments. Exemplary of the invention is a process comprising providing a (computer-controlled) apparatus at the point-of-sale on which a user selects paint characteristics, after which the (pre-paint) components necessary to provide such characteristics are dispensed or deposited into empty receptacles and agitated to produce a final paint composition.

The applied references are all considered to teach methods for producing paint compositions comprising processes that employ aqueous "pre-mixes" as claimed by applicants to arrive at final paint compositions having final desired properties. The references each have different terminology for this concept, i.e. "using modular systems", "component mixing" and delayed product differentiation" ; however each of the references discloses substantially the same process set forth in the instant application, namely the selection of a desired color, gloss, durability or other paint characteristics and the computer controlled dispensing and mixing of semi-finished products, i.e. "components" into a final paint composition. Accordingly, it is considered that the prior art documents are directed to an invention that significantly overlaps in

scope that set forth in the prior art, and overlapping subject matter has long been held to constitute a prima facie case of obviousness.

Although the entire disclosure of the applied references is highly relevant, see particularly the drawing, columns 1 and 2, column 5, lines 23-36 and the examples of U.S. 4,403,866, column 1, line 57 – column 3, line 38 of U.S. 5,672,649, page 156 of "Component Mixing - A new approach to Customized paint production" document, page 228, last full paragraph – page 232 of the "Paint Dispensing System" document, See the entire disclosures of the remaining documents.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 108-206 and 268-300 of copending Application No. 09/578,001. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ from one another only in the scope of coverage being sought. The two sets of claims seem



to simply cover different embodiments of the same invention, but they are substantially overlapping in scope and are directed to the same inventive concept.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants are advised that any evidence to be provided under 37 CFR 1.131 or 1.132 and any amendments to the claims and specification should be submitted prior to final rejection to be considered timely. It is anticipated that the next office action will be a final rejection.

Claims 1-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-6 of U.S. Patent No. 6,221,145. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ from one another only in the scope of coverage being sought. Certain limitations in the claims not set forth in the patented claims include limitations that have been considered but are not deemed to patentably distinguish the instant claims. Examples of such are computer control (as shown by references of record) or transport of the material to point-of-sale (so notoriously well-known as to preclude the citation of a reference).

### ***Conclusion***

Applicants should keep in mind all prior art of record when amending the instant application. For example, prior art such as U.S. Patent No. 5,521,234 teaches that it is known in the art to manufacture in the factory paint lines using aqueous solutions rather than dry powders. Such technology could be considered to have relevance to the

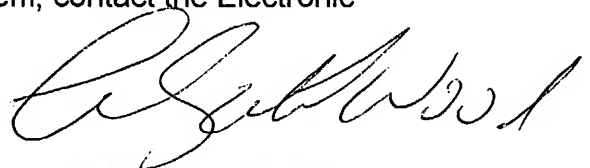
instant claims since limitations such as storing, transferring to the point-of-sale and so forth are not considered to impart patentability to the instantly claimed process.

Applicants are advised that any evidence to be provided under 37 CFR 1.131 or 1.132 and any amendments to the claims and specification should be submitted prior to final rejection to be considered timely. It is anticipated that the next office action will be a final rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth D. Wood whose telephone number is 571-272-1377. The examiner can normally be reached on M-F, 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 571-272-1364. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ELIZABETH D. WOOD  
PRIMARY EXAMINER

5/19/04